

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-22 were pending in the application and were rejected in the Office Action. Applicants have not amended the claims.

1. Priority Document

Applicant acknowledges the Examiner's notation that a certified copy of the German priority document DE 10108254.1 has not previously been filed. The priority document is being filed concurrently herewith.

2. Rejection of Claims 1 and 3 under 35 U.S.C. § 102(e)

The Examiner rejected claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0036763 ("Krikke"). This rejection is now due to the filing of the certified copy of the priority document, the filing date of which (*i.e.*, February 21, 2001) antedates Krekke's § 102(e) of July 3, 2001. *See* M.P.E.P. § 2136.05. Figures 1, 2, and 3 of the priority document (which correspond to Figures 1, 2A, 2B, and 3 of the instant application) provide support for claim 1 and 3. If the Examiner deems the figures insufficient to provide the necessary support for claims 1 and 3, Applicant will file a translation of the priority document. If, at that time, the Examiner denies the claim for priority, Applicant reserves the right to argue the merits of the rejection.

3. Rejection of Claims 1-21 under 35 U.S.C. § 102(e)

Although the Examiner stated that claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,715,704 ("Biber") in view of U.S. Patent No. 6,305,801 ("Kerns"), the Examiner set forth no basis for a rejection with respect to claims 20 and 22. In addition, the Examiner subsequently rejected claim 20 under § 103(a) as being obvious when considering Biber in view of Kerns and further in view of U.S. Patent No. 6,271,968 ("Dobrowolski"). Accordingly, Applicant assumes that the Examiner intended to reject claims 1-19, 21, and 22 under § 103(a) as being obvious when considering Biber in view of Kerns, *i.e.*, if claim 20 were obvious when considering Biber in view of Kerns, there would be no reason to reject the claim as being obvious when considering Biber in view of Kerns and Dobrowolski.

a. Rejection of Claims 1-19 and 21

Applicant traverses the rejection of claims 1-19 and 21 for the following reasons.

Claim 1 recites an optical device in which, among other things, a

spectral filter is adapted to reduce, *without eliminating*, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam.

As noted in the italicized portion, the spectral filter is adapted to reduce the intensity of the light passing through a specific subsection thereof, “without eliminating” it. By way of contrast, Biber teaches a *light trap* which includes a black spot 4 in a diaphragm 3 to create an unlighted portion 6. *See* Biber at title and at col. 2, lines 43-62. The purpose of the black spot 4 is to prevent high intensity light from contacting a particular portion of an eye by preventing the light from passing through a particular subsection of the diaphragm 3. *See id.*

The Examiner acknowledges this deficiency of Biber in stating: “Biber does not disclose a filter, as opposed to the diaphragm, with the transmission characteristics as specified in the claims of the instant application.” To remedy this deficiency, the Examiner relies on Kerns and the contact lens 10 disclosed therein. As hereafter explained in detail, however, the Examiner’s reliance on Kerns is misplaced as there is no motivation to combine the references.

Biber teaches that the black spot 4 on the diaphragm 3 is necessary “to prevent injury to or impairment of the eye of [a] patient.” *See* Biber at col. 1, lines 18-19. The injury which Biber addresses is a direct result of the intensity of the light being irradiated onto the eye. *See id.* at lines 14-17. Accordingly, one of ordinary skill in the art who is trying to protect a particular portion of an eye (e.g., the cornea) from high intensity light would not be motivated to act counter to Biber’s express teaching by allowing filtered light to contact that particular portion the eye. By way of corollary, if someone is highly allergic to shellfish and one doctor says, “to avoid death, don’t eat shellfish,” another doctor would not later be motivated to say, “to avoid death, eat less shellfish.” Accordingly, one of ordinary skill in the art upon reading Biber would clearly not be motivated to apply the filter teachings of Kerns. Support for this argument is presented in M.P.E.P. § 2143.10 which provides: “If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

For at least the aforementioned reason, Biber and Kerns can not properly be combined under 35 U.S.C. § 103(a) to reject claim 1 or any claim dependent thereon. Therefore, as claims 2-19, 21 and 22 depend from claim 1, each of these claims is also allowable, without

regard to the other patentable limitations recited therein. Applicant respectfully requests a withdrawal of the rejection of claims 1-19, 21 and 22.

b. Rejection of Claim 20

As previously discussed, (a) Biber fails to teach or suggest a spectral filter “adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam” and (b) Kerns can not properly be combined with Biber to cure this deficiency. For the following reasons, as Dobrowolski can not be combined with Biber to remedy this deficiency, Applicant respectfully traverses the rejection of claim 20.

Although Dobrowolski teaches a filter which may be of appropriate size to fit within the optical device disclosed in Biber, one of ordinary skill in the art would not have been motivated to modify Biber’s optical device by the teachings of Dobrowolski. As previously discussed, the intention of Biber was to eliminate the potential for high intensity light to be incident on a particular portion of an eyeball. Accordingly, for the reason previously set forth with respect to the inapplicability of Kerns, one of ordinary skill in the art who intends to eliminate light would not have been motivated to look to the filter teachings of Dobrowolski.

For at least the aforementioned reason, Biber, Kerns and Dobrowolski can not properly be combined to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Accordingly, as claim 20 depends from claim 1, it is also allowable, without regard to the other patentable limitations recited therein. Therefore, the rejection of claim 20 should be withdrawn.

CONCLUSION

For the aforementioned reasons, claims 1-22 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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By



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THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HEREWITH, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HEREWITH, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.